

### **REMARKS**

This Response and Amendment is filed in response to the Office Action dated March 2, 2005.

Claims 1-8 and 10-31 are pending in this application. The Applicant gratefully acknowledges the Examiner's indication that Claims 10-12 and 21-23 contain allowable subject matter. By this Amendment, Claims 2-4, 6, 10, 13, 16, 18, 19, and 26-30 are amended and Claims 1 and 31 are cancelled, leaving Claims 5, 7, 8, 11, 12, 14, 15, 17, and 20-25 unchanged. Claims 2-8 and 10-30 are presented for consideration by way of the present Response and Amendment.

On page 2 of the Office Action, the Examiner has objected to the drawings under 37 CFR 1.83(a) as not showing every feature of the invention specified in the claims. Specifically, the Examiner states that the "gearbox" and "first and second motors" from Claims 13-17 are not shown in the drawings. The Applicant respectfully submits that the "gearbox" and "first and second motors" are shown in FIG. 1 of the drawings as the enclosed geartrain 42 and the motors 50, respectively.

On page 3 of the Office Action, Claim 20 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner states that there is insufficient antecedent basis for the limitation, "the tray," in Claim 20. By this Amendment, Claim 20 is ultimately dependent from amended Claim 10, which recites the limitation, "at least one tray." The Applicant respectfully submits that amended Claim 10 does not include the limitation, "a plurality of trays," and that Claim 10 provides sufficient antecedent basis for the limitation, "the tray," in Claim 20. Accordingly, the Applicant respectfully requests withdrawal of the 35 U.S.C. §112 rejection of Claim 20.

Also on page 3 of the Office Action, Claims 1-8, 13, 18, 19, 20, and 26 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 1,667,483 issued to Leof. On page 4 of the Office Action, Claims 1, 10, 19, 20, 24, 25, 27, 30, and 31 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,836,737 issued to Hashimoto et al. (hereinafter "Hashimoto"). Also on page 4 of the Office Action, Claims 1, 4, 16, 17, 20, and 27-29 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,545,714

issued to Johnson et al. (hereinafter "Johnson"). On page 5 of the Office Action, Claims 14 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Leof.

By this Amendment, independent Claim 1 is cancelled. Therefore, the Examiner's 35 U.S.C. §102(b) rejections of Claim 1 are moot.

Newly-independent Claim 10 recites (underlining added for emphasis):

A storage device for storing trays, comprising:  
a first rotatable member;  
a second rotatable member positioned opposite the first rotatable member, the first and second rotatable members adapted to selectively support at least one tray therebetween; and  
at least one transfer mechanism movable relative to the tray to selectively insert and remove the tray between the first and second rotatable members.

On page 4 of the Office Action, Claim 10 is rejected under 35 U.S.C. §102(b) as being anticipated by Hashimoto, while on page 5 of the Office Action, Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim. The Applicant respectfully submits that the Examiner's 35 U.S.C. §102(b) rejection of Claim 10 is erroneous because Hashimoto does not teach or suggest a transfer mechanism movable relative to a tray to selectively insert and remove the tray between first and second rotatable members, as claimed in newly-independent Claim 10. Rather, Hashimoto discloses an endless chain link device 21 having attached lifting plates 20. The endless chain link device 21 is driven in a counter-clockwise direction, as shown in FIG. 1, such that the lifting plates 20 pick up successive stacks of containers "A" for insertion into the reversing conveyor 30. The Applicant respectfully submits that the endless chain link device 21 is not configured to remove the containers from the reversing conveyor 30 after the containers have been inserted into the reversing conveyor 30. Hashimoto fails to teach or suggest that the endless chain link device 21 is movable to selectively insert and remove the containers from the reversing conveyor 30.

Accordingly, the Applicant respectfully submits that the Examiner's objection to Claim 10 is proper and newly-independent Claim 10 is allowable.

Claims 2-8 and 11-26 are each ultimately dependent upon newly-independent Claim 10, and are believed to be allowable based upon newly-independent Claim 10 and upon other features and elements claimed in Claims 2-8 and 11-26 but not discussed herein.

Independent Claim 27 recites (underlining added for emphasis):

A method for storing trays, comprising:  
transporting a first tray to a transfer position;  
lifting the first tray from the transfer position to a storage position;  
supporting the first tray in the storage position by two opposed rotatable members; and  
lowering the first tray from the storage position to the transfer position.

Neither Hashimoto nor Johnson teach or suggest a method for storing trays including lifting a first tray from a transfer position to a storage position, supporting the first tray in the storage position by two opposed rotatable members, and lowering the first tray from the storage position to the transfer position, as claimed in amended Claim 27. Rather, Hashimoto discloses a stacked container separating apparatus and method in which successive stacks of containers "A" are transported to a lifting device 2. The lifting device 2 utilizes the endless chain link device 21 and lifting plates 20 to feed the successive stacks of containers into the reversing conveyor 30. The reversing conveyor 30 then inverts the individual containers and releases them onto a discharge conveyor 4. The Applicant respectfully submits that the lifting device 2 is incapable of lowering a stack of containers after those containers have been inserted into the reversing conveyor 30 because the reversing conveyor 30 transports the individual containers away from the lifting device 2 and toward the discharge conveyor 4. Hashimoto fails to teach or suggest that the lifting device 2 can also be used to lower containers after those containers have been inserted into the reversing conveyor 30.

Johnson discloses a method for forming stacks of nested containers, in which a conveyor 14 delivers individual containers "C" to a conduit 12. The containers are blown through the conduit 12 by pulses of air. From the conduit 12, the containers enter a first station 18 including wheels 32 having bristle-like circumferential surfaces. The wheels 32 continually impart downward pressure on the containers, therefore causing them to nest. The nested containers then enter a second station 20, including wheels 40 having resilient members 42 for

maintaining a predetermined feed rate of containers through the second station 20. Endless conveyor chain drives 50 include respective clips 54 adapted to engage the edges of the containers. The speed of the chain drives 50 is higher than that of the wheels 40, such that for each revolution of the chain drives 50, a predetermined count of containers will be separated from the nested stack. On page 4 of the Office Action, the Examiner states that the chain drives 50 and the wheels 40 support the containers in a storage position. The Applicant respectfully submits that neither the wheels 40 nor the chain drives 50 support the containers in a storage position. Rather, the wheels 40 maintain the feed rate of the containers through the second station 40, while the chain drives 50 merely separate a predetermined count of containers from the nested stack. Johnson fails to teach or suggest that either the wheels 40 or the chain drives 50 can support the containers in a storage position.

In addition, the Applicant respectfully submits that the conduit 12 is incapable of transferring the containers back to the conveyor 14 after the containers have been inserted into the first station 18. The conduit 12 merely provides for transport in one direction only - away from the conveyor 14 and toward the first station 18. Johnson fails to teach or suggest that the conduit 12 can lift the containers from a transfer position to a storage position, and lower the containers from the storage position back to the transfer position.

Accordingly, the Applicant respectfully requests withdrawal of the 35 U.S.C. §102(b) rejections of amended Claim 27.

Claims 28-30 are each ultimately dependent upon amended Claim 27, and are believed to be allowable based upon amended Claim 27 and upon other features and elements claimed in Claims 28-30 but not discussed herein.

CONCLUSION

In view of the amendments and remarks presented herein, it is respectfully submitted that the claims as amended are in condition for allowance. The Applicant kindly requests that the Examiner telephone the attorneys of record in the event a telephone discussion would be helpful in advancing the prosecution of the present application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'C F Laska' with a stylized flourish at the end.

Casimir F. Laska  
Reg. No. 30,862

Michael Best & Friedrich LLP  
100 East Wisconsin Avenue  
Milwaukee, Wisconsin 53202-4108  
(414) 271-6560